

REMARKS/ARGUMENTS

Claims 1 to 3, 5, 10, 11, 14, 16 and 17 are pending. Claim 4 was earlier cancelled. Claims 6 to 9, 12 and 13 have been cancelled. Claim 1 has been amended. New Claims 16 and 17 has been added and are similar to amended Claim 1.

The amendment filed June 7, 2007 has been objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. Applicant traverses this objection as new matter is clearly not involved.

The Office Action stated that 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. No new matter has been introduced into the disclosure of the invention (or into the specification). The drawings are part of the original disclosure of the invention so no new matter is involved. Applicant's disclosure describes and discloses several inventions, with each such invention encompassing a number of variations having disclosed scopes ranging from broad to narrow. The applicant is presently claiming a variation of the elected invention that has reduced scope. The Examiner has admitted that the drawings (which are part of the original disclosure of the invention) do not have any holes in the walls. The Examiner has, thereby, shown that there is no new matter involved.

If an applicant discloses something he can claim it (and insert it into his specification).

The M.P.E.P., Section 608.4, states:

"In establishing a disclosure, applicant may rely not only on the specification as filed but also on the original claims if their content justifies it". [Emphasis Supplied]

Even an original abstract or an original drawing is original disclosure.

Claims can have negative limitations, [see M.P.E.P., 2173.05(i)].

The Office Action stated that the added material which is not supported by the original disclosure is as follows: The statement that "The front wall and the back wall do not contain any holes" is considered new matter, as such is a negative limitation which precludes holes, which the original specification did not disclose as being precluded, and was not generated by applicant's original disclosure, but by the pertinent prior art. Applicant traverses this statement since the added material is supported by original disclosure. The drawings show walls without any holes in them so applicant can claim walls without any holes therein (and insert such into the specification). A wall that does not have any holes in it can be described in many ways that are correct. Applicant chose one way, as is his right. The Examiner has not shown that such way is wrong by showing that the disclosed walls have holes in them.

The Office Action stated that, while it is clear that there are no holes in the disclosed walls, the original specification does not preclude holes per se, anymore than it precludes sundry other elements it does not include. Applicant traverses this statement as being illogical. The invention that applicant is claiming is based in part on the original drawings, that is original disclosure. The Examiner's statement recites only the original "specification", which is only part of the original disclosure. The original drawings support the subject amendment to

the specification and claims. The Examiner has admitted that there are no holes in the disclosed walls.

This application (specification) states that the invention packaging bag can be used for, among other things, medications in the form of tablets or powder. Holes in the walls would allow contaminating substances and moisture into the interior of the packaging bag and would allow the contents of the packaging bag to fall out of the packaging bag.

If a drawing shows a wall that does not have any holes in it (as admitted by the Examiner), it is factual and inherent that such wall does not have any holes in it. The Examiner's continued comment about preclusion of sundry and other elements is not relevant.

The Office Action stated that applicant may define the walls as being "continuous and uninterrupted" which is a positive statement of the structure originally disclosed. Applicant has added this positive limitation statement to independent Claim 1 and inserted into the specification, in addition to the already present negative limitation. See also new independent Claims 16 and 17.

The Office Action stated that applicant is required to cancel the new matter in the reply to this Office Action. Applicant traverses this requirement because, as shown above, no new matter is involved.

This objection should be withdrawn.

The Office Action stated that the following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full,

clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 to 3, 10 and 11 have been finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicants traverses this rejection for the reasons given above and hereafter.

Applicant has shown that no new matter is involved.

The Office Action stated the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant traverses this statement for several reasons. This statement is not even a correct statement of the law set out in Section 112, first paragraph. An original drawing is original disclosure and the content of the drawing (e.g., in description form) can be inserted into a specification and a claim after the application has been filed. So a specification does not have to contain such original disclosure in an original drawing "at the time the application was filed" – such original disclosure can be inserted into a specification and a claim at a date after an application is filed. Reference is made to M.P.E.P., Section 608.4.

The Office Action stated that, in Claim 1, lines 5 and 6 the limitation "do not have any hole therein" is a negative limitation precluding holes, which was not contemplated by applicant by his original disclosure. Applicant traverses this statement as being incorrect and unsupportable. Applicant's original disclosure

did (and does) show that he contemplated such limitation because the drawings, that are original disclosure, show and support such limitation.

The Office Action stated that applicant should positively define his walls such as by - are continuous and uninterrupted - . Applicant has added this positive definition statement to independent Claim 1.

This rejection should be withdrawn.

The Office Action stated that the following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 to 3, 10 and 11 have been finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant traverses this rejection.

This rejection could have been made in the prior Office Action since the language asserted to be indefinite has even been in the original claims. The Examiner is supposed to make the first Office Action complete, but the first and other Office Actions were not complete. Therefore, applicant requests that this Final Office Action be withdrawn, and a new non-final Office Action be issued or the application be allowed.

The Office stated that in Claim 1, line 8, "substantially the entire area" is indefinite, as such encompasses all but an insignificant part of the area, and leaves no area for the subsequently defined "remaining portion". Applicant

traverses this statement. The phrase is not indefinite and is fully supported in the specification.

The “remaining portion” of the cover film (20, 20ab) is permanently bonded to the packaging film in an edge area. While this film permanently bonded edge area does not have to be large, and can be small to achieve such function, it certainly is not “no area” (as asserted by the Examiner). The Examiner has also asserted that the “substantially the entire area” encompasses “all but an insignificant part of the area”. This assertion shows that the Examiner’s position is incorrect.

Webster’s Ninth New Collegiate Dictionary, (1989) states:

“insignificant ...d: small in size...”

[Page 626]

Small size of the permanently bonded area is sufficient for an operable version of applicant’s claimed invention so the rejected phrase is not indefinite.

Note that “insignificant” does not mean “no” area.

Webster’s Ninth New Collegiate Dictionary, ibid., states:

“substantial...5: being largely but not wholly that which is specified...”

[Page 1177]

Page 1, lines 35 and 36 of this application states:

..., substantially the entire area of which is bonded to and peelable from...”

The Office Action stated that the phrase “substantially the entire area” should be – a substantial portion--, to indicate there are two portions of significant area. This is an incorrect interpretation. The phrase “a substantial portion”

means a large area portion so the "remaining portion" is a small area portion. Claim 1 has been amended to recite "a substantial portion". New Claim 16 contains the phrase from the original claims and specification.

This rejection should be withdrawn.

Claims 1, 2, 5, 10, 14 and 15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Counts et al. (U.S. Patent No. 5,341,930) in view of Kaufmann (U.S. Patent No. 5,389,415). Applicant traverses this rejection.

The Office Action stated that Counts et al. discloses a packaging bag (Figures 1 and 2) with a front wall (14) and a rear wall (12) in which the front wall and rear wall are bonded together along a peripheral edge (column 6, lines 39 to 47), each of the front wall and rear wall being continuous and uninterrupted so as to not have any hole therein, at least one of the front wall and rear wall bonded to a cover film (16) which is printed on one or both sides, substantially the entire area of the cover film being bonded to and peelable from the at least one of the front wall and rear wall, and at least one of the front wall and rear wall of the packaging bag printed on the outside of the bag (at 20). Applicant traverses this statement as being incorrect and incomplete. Counts et al. does not contain any portion of a cover film that is permanently bonded to any portion of a packaging film. This is one of the core/major parts of the invention of Counts et al. See column 2, line 56, to column 3, line 4, of Counts et al. If Counts et al. did have any portion of a cover film permanently bonded, the invention of Counts et al. would be destroyed.

Counts et al. is not a relevant reference since it requires complete removal of outer sheet 16 to uncover the printing on middle sheet 14. To leave special

advertising outer sheet 16 of Counts et al. permanently hanging from the package would destroy its usefulness as being readily convertible to market goods under general nature advertising on middle sheet 14.

Counts et al. directs away from permanently bonding at least one edge area of its cover film because doing so would destroy the invention of Counts et al. The insertion of Kaufmann et al. into Counts et al. would destroy the Counts et al. invention. One ordinarily skilled in the art, accordingly, does not have the necessary motivation to combine Counts et al. and Kaufmann in the manner incorrectly attempted by the Examiner in the quest for applicant's claimed invention. The Examiner has used forbidden hindsight.

The Office Action stated that Kaufmann discloses a substantial portion of a cover film (2) bonded to and peelable from a package and a remaining portion (5) of the cover film permanently bonded to a packaging bag in an edge area. Kaufmann does not cure the defects of Counts et al. in the search for applicant's claimed invention. One ordinarily skilled in the art would not use a permanent bonding adhesive to bond part of Counts et al. because it would destroy the invention of Counts et al. that requires complete removal of outer sheet 16.

Section 103(a) is based on one ordinarily skilled in the art.

The Office Action stated that to modify the packaging bag of Counts et al. employing the peelable and permanent seal combination teaching of Kaufmann would have been obvious in order to permanently retain the cover film with the bag, yet allow its partial peeling to ascertain text hidden beneath the cover film, as suggested by Kaufmann. This statement is in error and is meaningless under Section 103(a). This statement only states that it "would have been obvious" and

is not based on being obvious to one ordinary skilled in the art, so it is of no meaning under the Patent Statute (which governs the Examiner's examination).

The Examiner has not even asserted to whom his attempted combination would be obvious. This rejection is clearly defective.

The burden of proof under Section 103(a) is on the Examiner, and he has not carried his burden of proof. The M.P.E.P. states that it is Patent Office policy to follow the Graham decision. The Examiner has not factually made in the record the mandatory resolution of the level of ordinary skill in the art.

Accordingly, the Examiner has not followed Patent Office policy or the Supreme Court requirements in its Graham decision. Accordingly, the Examiner does not know anything about one ordinarily skilled in the art or what would be obvious to such person. To say something is obvious is meaningless unless Patent Office policy or the Graham decision have been complied with. The recent Supreme Court KSR decision affirmed that the level of ordinary skill in the art had to be factually resolved in the record. The new Examination Guidelines state the same thing. The Patent Office requires that action of the Examiner be based exclusively on the written record of the Patent Office. See 37 C.F.R. 1.2.

There has not been any factual showing in the record of prima facie obviousness because the Examiner has not complied with the Graham decision.

The Office Action stated that applicant's arguments with respect to Claim 1 to 3, 5, 10, 11, 14 and 15 have been considered but are moot in view of the new grounds of rejection. The new obviousness rejections are defective on their face.

The Office Action stated that applicant appears to believe that any modification of one reference with the teaching of another “destroys” the modified reference. Applicant traverses this statement as being groundless. The burden of proof is upon the Examiner (which he has not carried) to show first in the record that one ordinarily skilled in the art would make such a modification.

The Office Action stated: see *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). These court decisions are not pertinent to the controlling issues in this case.

M.P.E.P. 2143.01, states:

“V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE”

“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)...” [Emphasis Supplied]

M.P.E.P. 2143.01, (VI), states:

“VI. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE”

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to

render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)..." [Emphasis Supplied]

The Office Action stated that the Examiner maintains that it would have been obvious to provide a permanent seal to the structure of Counts et al. as taught by Kaufmann in order to maintain the cover film with the packaging, as suggested by Kaufmann. This statement is meaningless under Section 103(a), as shown above. Section 103(a) requires one ordinarily skilled in the art.

The Office Action stated that, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. This statement has nothing to do with any of applicant's overcoming of any of the present or prior obviousness rejections. The Examiner's comments clearly show the meaningless of this statement. The Examiner has attached (incorrectly) applicant's arguments of inserting Kaufmann into Counts et al. – the Examiner's above statement has no factual basis in the record. Applicant's comments dealt with defeat (successfully) of the comments of the combination of rejection references.

Even if combined, the combination of Counts et al. and Kaufmann does not result in and is not suggestive of applicant's claimed invention.

The Office Action stated that, to modify an existing reference invention with an improvement thereto already recognized in the art does not "destroy" the existing invention in this case, any more than replacing my old frayed carpet in my living room with hardwood floors was unobvious to me, nor would it destroy my existing house by so doing. This statement has nothing to do with the requirements of

Section 103(a), the Patent Office policy and Examination Guidelines, and the controlling Supreme Court decisions and the M.P.E.P. The Examiner has not factually proven that Kaufmann is an improvement on Counts et al. already recognized in the art. In fact, Kaufmann is a destruction of Counts et al.

Kaufmann is not even pertinent to Counts et al. – Counts et al. was not cited against Kaufmann. The two rejection references are not relevant or combinable.

The Office Action stated that, as to Claim 2, Counts et al. discloses a first packaging film (14), a second packaging film (12) and a cover film (16). This claim is not obvious since the generic claim is not obvious.

The Office Action stated that, as to Claim 10, Counts et al. disclose bonding of the cover film in an edge area. This claim is not obvious since the generic claim is not obvious.

The Office Action stated that, as to Claim 14, Kaufmann further disclose employing permanent adhesive (see column 2, lines 43 to 55). This claim is not obvious since the generic claim is not obvious.

The Office Action stated that, as to Claim 15, since the prior art combination discloses printing in general, and applicant discloses register printing to be known in the field, to employ the commonly known register printing process would have been obvious to one of ordinary skill in the art and would fail to define any new and unexpected result by its employment. The Examiner's continued reference to being "obvious" without even reference to one ordinarily skilled in the art, for example, shows that this rejection fails.

Withdrawal of this rejection is requested.

Claims 3 and 11 have been finally rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to Claim 1 above, and further in view of Muir et al. (U.S. Patent No. 6,767,604). Applicants traverse this rejection for the above reasons.

The Office Action stated that Muir et al. discloses the front wall and the rear wall of a similar bag being of the same packaging film by folding (see column, lines 46 to 61). The result is still no combination of Counts et al. and Kaufmann as a basis to add Muir et al.

The Office Action stated that, to provide the front and rear walls of Counts et al. as folded portions of the same material would have been obvious, as it is well-known in the bag field to provide a bag by folding a single sheet, as disclosed by Muir et al. "Obvious" to whom? A genius in the art – sorry, wrong standard.

Muir et al. requires a (dispensing) hole in the film/wall located under the label. The use of Muir et al. in the rejection combination would destroy applicant's claimed invention.

This rejection should be withdrawn.

The Office Action stated applicant's amendment necessitated the new grounds of rejection presented in this Office Action. This statement is clearly in error. As applicant has shown above, the Examiner has made a new rejection under 37 C.F.R. 112 that definitively establishes that the Examiner has never previously made a complete Office Action as required by M.P.E.P. 707.07. The Examiner is requested to issue a new non-final Office Action that is complete, and follows Rule 707.07 and Patent Office policy.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

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Virgil H. Marsh
Virgil H. Marsh
Reg. No. 23,083

Fisher, Christen & Sabol
1725 K St., NW
Suite 1108
Washington, DC 20006
Tel.: 202-659-2000
Fax: 202-659-2015
fcsabol@aol.com

<p align="center">CERTIFICATE OF MAILING</p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AAF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on <u>Oct. 18,</u> 2007.</p> <p align="center"><u>Virgil H. Marsh</u> FISHER, CHRISTEN & SABOL 1725 Street, N.W., Suite 1108 Washington, D.C. 20006</p>
